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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Chaim SPRINGER et al.
Title: DIAGNOSTIC MICROSPHERES
Application No.: 10/522,200
International Filing Date: 07/03/2003
Date: 371(c) Date: 1/24/2005
Examiner: JEAN CORNET
Art Unit: 4121
Confirmation No.: 8842

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the restriction and election of species requirement set forth in the Office Action mailed February 26, 2009, Applicants hereby provisionally elect Group I, claims 8-13 and 15, drawn to a diagnostic method, with traverse.

The PTO has imposed a formal restriction between two allegedly different inventive groups. Group I (claims 8-13 and 15) is drawn to a diagnostic method while the second inventive group is directed to a food product (Group II, claims 14).

The PTO asserts that the common technical feature in both groups are the “biodegradable polymeric microspheres”, which PTO states is disclosed in U.S. Patent 5,205,290 (Unger et al., ‘290 patent). Contrary to the PTO’s assertion, however, Unger does not disclose microspheres whose size is in the range recited by claim 8. Further, Unger is silent about the use of biodegradable polymeric microspheres for detecting pulmonary aspiration or gastroesophageal reflux, rather, focusing on the

use of the disclosed microspheres to improve computed tomography images of the gastrointestinal tract. Thus, the claims are novel under the unity of invention rules set forth in 37 CFR § 1.475.

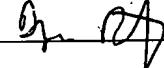
In addition, the PTO requires Applicants to elect a species if Group I is elected. See Office Action on page 3. To comply with the PTO's requirement, Applicants elect "polyester" as the polymeric material along with homopolymers and copolymers of "lactic acid" as the corresponding elected species.

Furthermore, claim 14 of Group II is drawn to a product that includes the novel microspheres. Thus, claim 14 also possess unity of invention under the applicable standards. In view of these remarks, Applicants urge the PTO to reconsider and withdraw the restriction requirement. Applicants also reserve the right to file a divisional application covering the subject matter of the non-elected claim 14.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, the Commissioner is authorized to charge the unpaid amount to the same deposit account. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extension fees to above mentioned deposit account.

Respectfully submitted,

Date March 26, 2009

By 

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